

REMARKS

I. Status of the Claims

Claims 25, 26, 34-46, 48-56 are currently pending. Applicants acknowledge, with appreciation, that the Examiner has indicated that claims 48-50 are allowed. Applicants have canceled claim 33 without prejudice or disclaimer to the subject matter contained therein. Applicants have changed the dependencies of claims 25, 26, 34, 35, and 55 from claim 33 to claim 48. In addition, Applicants have amended claim 39 to include the allowable subject matter noted by the Examiner, i.e., that the mechanical embossing step is performed subsequent to chemical embossing. Support for this amendment can be found in claim 48, which the Examiner indicated is allowed. In addition, the amendment to claims 54-56, to recite that "the mechanically embossed portion of the wear layer does not include the chemically embossed portion," is supported in the sentence bridging pages 11-12 of the present specification.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 25, 26, 34-50, and 55 in condition for allowance. Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Furthermore, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

II. Rejection Under 35 U.S.C. §112, 1st paragraph

The Examiner has maintained the rejection of claims 54-56 under 35 U.S.C. §112, 1st paragraph as allegedly containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the invention.

While Applicants respectfully disagree and maintain their traversal for the reasons of record, to advance prosecution, Applicants have amended claims 54-56 to recite that “the mechanically embossed portion of the wear layer does not include the chemically embossed portion.”

As previously indicated, the paragraph bridging pages 11-12 of the present specification teaches that the “portion of the foam layer which has been overlayed with the design layer having the retarder composition is not mechanically embossed.” In other words, the present specification clearly supports the claimed element that the mechanically embossed portion of the wear layer does not include the chemically embossed portion, as recited in claims 54-56. Because the specification expressly supports a mechanically embossed portion of the wear layer that does not include the chemically embossed portion, claims 54-56 meet the requirements of 35 U.S.C. §112, 1st paragraph. Applicants thus request that this rejection be withdrawn. Furthermore,

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

because there are no outstanding art rejections of these claims, Applicants respectfully request that the Examiner indicate their allowability.

III. Rejection Under 35 U.S.C. §103

The Examiner has maintained the rejection of claims 25, 26, 33-46, 51 and 52 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,214,028 to Shortway et al. ("Shortway") for the reasons of record. Applicants respectfully traverse this rejection for the reasons of record, and the following additional reasons.

The Examiner has indicated that claims 48-50 are allowed because they recite the sequence of steps not taught by Shortway, e.g., mechanical embossing subsequent to chemical embossing. To advance prosecution, and in no way acquiescing to the correctness of this rejection, Applicants have similarly amended claim 39. Thus, independent claims 39 and 48, and each claim dependent therefrom (i.e., claims 25, 26, 34-38, 40-46, 49, 50, 55, and 56) are allowable over the prior art. The only outstanding prior art issues have to do with claims 51-53. For the following reasons, however, Applicants also believe that these claims are patentably distinct from Shortway.

The common feature recited in claims 51 and 53 is that they are directed to methods of making a surface covering comprising a wear layer having a uniform melt viscosity. Claim 53 additionally recites a process in which the wear layer is applied before chemically embossing, and cured prior to mechanically embossing. Claim 52 is directed to a method of making a surface covering comprising mechanically embossing

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

only a portion of the wear layer. Shortway simply does not teach the features of a wear layer having a uniform melt viscosity or mechanically embossing only a portion of the wear layer. In fact, Shortway expressly teaches away from these elements. For example, because Shortway is directed to a method in which mechanically embossing occurs prior to chemically embossing, it **requires** a wear layer that necessarily does not have a uniform melt viscosity. Shortway teaches that:

As a result [of the first mechanical embossing step], such portions of the **wear layer possess an increased melt viscosity** therein and a harder, more resistant surface which is capable of resisting any softening or melting tendencies **during the subsequent heating involved in the blowing or foaming procedure.**

Col. 19, lines 41-46 (emphasis added).

Similarly, the mechanical embossing step of Shortway is described as mechanically embossing "the entire surface." Col. 20, lines. In describing the mechanical embossing procedure, Shortway teaches, in relevant part:

At the conclusion of the mechanical embossing procedure, **the entire surface of the wear layer is embossed** so as to give it temporarily the desired flat, dead, or dull mat finish or texture **all over.**

Col. 18, lines 62-65 (emphasis added).

It is clear that Shortway expressly teaches away from the elements recited in claims 51-53, and thus cannot render these claims obvious. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference. Motivation may be lacking when the state of the art at the time of the invention in question was discovered pointed researchers in a different direction than the inventor proceeded. Indeed, the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Federal Circuit has repeatedly recognized that proceeding contrary to the accepted wisdom in the art represents "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

As shown, Shortway clearly pointed researchers away from using a wear layer having a uniform melt viscosity. Indeed, because Shortway describes a method of first mechanically embossing the entire wear layer, it necessitates the use of a wear layer that does not have a uniform melt viscosity. Accordingly, this reference does not provide the requisite motivation to achieve the claimed invention. For this reason alone, Shortway does not render the claimed invention obvious.

Shortway also does not provide a reasonable expectation of successfully achieving the claimed invention. As shown, Shortway is directed to a fundamentally different method than the method recited in claims 51-53. For example, Shortway expressly teaches mechanically embossing the entire wear layer, which necessarily requires that the wear layer **not** have a uniform melt viscosity. As taught by Shortway, the wear layer possess an increased melt viscosity to allow it to resist softening or melting tendencies during the subsequent heating involved in the blowing or foaming procedure. Col. 19, lines 41-46. Because Shortway expressly teaches away from using a wear layer having a uniform melt viscosity, there is no expectation that its use would successfully result in the claimed invention. Indeed, as taught in Shortway, just the opposite is true. For this additional reason, Shortway does not render the claimed invention obvious.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Finally, Shortway does not teach or suggest all of the claimed elements. As made clear, Shortway not only expressly teaches a method that involves first mechanically embossing the entire wear layer followed by a chemical embossing procedure, but it teaches the order of these steps require the use of a wear layer having a non-uniform melt viscosity. Nothing of record, other than Applicants' disclosure, describes either mechanically embossing only a portion of the wear layer or the use of a wear layer having a uniform melt viscosity, as claimed. For this additional reason, Shortway does not render the claimed invention obvious.

For these reasons, the Examiner has not met any of the three criteria, and certainly not all three, necessary for establishing a *prima facie* case of obviousness. In view of the foregoing, the *prima facie* case of obviousness advanced by the Examiner is improper. Applicants respectfully request that the rejection over Shortway be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the application and timely allowance of the pending claims. Please grant any necessary extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Louis M. Troilo
Reg. No. 45,284

Date: November 17, 2003

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com